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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/090,067	06/03/1998	JAMES D. REDMOND	NIS0007	3497

23735 7590 08/22/2002

DIGIMARC CORPORATION  
19801 SW 72ND AVENUE  
SUITE 100  
TUALATIN, OR 97062

EXAMINER

HENDERSON, MARK T

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 08/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/090,067

Applicant(s)

REDMOND ET AL.

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(e). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6,8-11,13-16,18-21 and 23-26 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

- 6) ☒ Claim(s) 1-6,8-11,13-16,18-21 and 23-26 is/are rejected.

- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXING of responses to Office Actions directly into the Group at (703)305-3579. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. The request filed on June 5, 2002 for a Continued Examination under 37 CFR 1.114 based on parent Application No. 09/090,067 is acceptable and a RCE has been established. An action on the RCE follows.

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-6, 8-11, 13-16, 18-21 and 24-26 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over UK Patent (GB-2159461A) in view of Dow (1,428,278).

UK Patent '461 discloses a document and method for manufacturing tamper-resistant identification cards comprising first printed matter (not seen, but mentioned in Col 2, lines 120-125) at a first location and a first scale, wherein the first printed matter is viewable by a person without magnification; a second printed matter (3) representing the first printed matter rendered at a second scale and location and in a second color, wherein the second scale (micro print) being significantly smaller than the first scale rendering the second printed matter not ascertainable (Col. 2, lines 125-129) by the naked eye and wherein the second location being spaced from the first location; and wherein the first and second printed matter conveys identifying information and is specific to the identified person (Col. 2, lines 107-115 and 120-123).

Patent '461 further discloses a method of printing a document which is inherently taught.

However, UK Patent '461 does not disclose minimal contrast hiding printed matter from

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the naked eye wherein the printed matter and a background color are printed in various hues; and a plurality of identification documents.

Dow discloses in Fig. 2 and 3, a document comprising printed matter in a first color and the background printed matter in a second color, wherein there is minimal contrast hiding between the printed matter and its immediate background which makes it hidden from the naked eye. (Col. 1, lines 41-51, and Col. 2, lines 63-71).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify UK Patent '461 document to include minimal contrast hiding between two colors as taught by Dow for the purpose of preventing the document from being counterfeited.

In regards to **Claim 11**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct any desirable amount of identification documents, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

In regards to **Claims 18-20**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place any desired indicia for the first and second printed matter, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Also, in the present case, there

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appears to be no new or unobvious structural relationship between the printed matter and the substrate.

*Response to Arguments*

3. Applicant's arguments filed on June 5, 2002 have been fully considered but they are not persuasive.

In response to applicant's arguments that the UK reference does not teach selecting a second color to effect minimal contrast between a second printed matter in a second location and its immediate background, the examiner submits that the Dow reference does indeed disclose a document comprising a printed matter (second) in a color, wherein there is minimal contrast between the printed matter and its immediate background (in another color) hiding the printed matter from the naked eye. This is shown in Fig 2 and 3, wherein the printed matter (star) in one color contrasts minimally from its immediate background (eagle) which is in a second color (Col. 1, lines 45-51, and Col. 2, lines 63-76). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify UK Patent '461 document to replace the second printed matter with printed matter that has minimal contrast hiding between its immediate background (at a second color) as taught by Dow for the purpose of preventing the document from being counterfeited.

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*Conclusion*

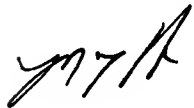
4. This is a first action final rejection. All claims are drawn to the same invention claimed in the earlier “parent” application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)305-3579. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

August 16, 2002



A. L. WELLINGTON  
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